

REMARKS

The Office Action mailed June 13, 2006, has been received and reviewed. Claims 1 through 7 and 9 through 21 are currently pending in the application. Claims 1 through 7 and 9 through 21 stand rejected. Applicant has amended claims 1, 12, and 17. Support for the amendments may be found throughout the as-filed specification, such as in paragraphs [0008] and [0009]. No new matter has been added. The amendments are made without prejudice or disclaimer. Reconsideration of the application as amended herein is respectfully requested.

**35 U.S.C. § 103(a) Obviousness Rejections**

Obviousness Rejection Based on U.S. Patent Publication 2002/0058193 to Tosaka *et al.* in view of U.S. Patent 5,025,292 to Steele and U.S. Patent 6,892,038 to Fukutani

Claims 1, 3, 4, 9 through 12, 14 through 18, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tosaka *et al.* (U.S. Patent Publication 2002/0059183) (hereinafter “Tosaka”) in view of Steele (U.S. Patent 5,025,292) (hereinafter “Steele”) and Fukutani (U.S. Patent 6,892,038) (hereinafter “Fukutani”) (collectively “the cited references”). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Regarding independent claims 1, 12, and 17, Applicant asserts that the cited references do not teach or suggest all of the claim limitations to establish a *prima facie* case of obviousness regarding the claimed inventions under 35 U.S.C. § 103. The cited references do not teach or suggest the claim limitation of the claimed invention reciting “to deliver a complete amount of the same color toners previously partially delivered to said target media” as recited in amended claims 1 and 12, or “to deliver complete amounts of the same color toners previously partially delivered to said target media” as recited in amended claim 17.

The Examiner asserted that the sequential deposition of color toners disclosed by Tosaka teaches “to deliver a partial amount of color toners” followed by a later delivery of “a complete amount of color toners.” *Office Action mailed June 13, 2006*, page 2. Tosaka only discloses that “[s]imilarly as the above-mentioned first color toner image forming cycle, second to fourth color toner images are separately formed on the photosensitive drum 1 and successively transferred onto the intermediate transfer belt 5 to form superposed color toner images corresponding to an objective color image.” *Tosaka*, paragraph [0179]. Tosaka discloses sequential deposition. The claims have been amended to clarify that “to deliver a complete amount of color toners” refers to the same colors that were previously partially delivered. Tosaka does not teach or suggest partial delivery followed by later complete delivery. Steele and Fukutani do not cure Tosaka’s deficiency. Therefore, for at least this reason, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established for amended claims 1, 12, and 17.

Claims 3, 4, 9 through 12, 14 through 18, 20, and 21 are non-obvious for at least the reason of depending from non-obvious base claims.

Obviousness Rejection Based on Tosaka in view of Steele and Fukutani, as applied to claims 1, 12, and 17 above, and further in view of U.S. Patent 6,002,893 to Caruthers, Jr. et al.

Claims 2, 5 through 7, 13, and 19 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tosaka in view of Steele and Fukutani, in view of claims 1, 12, and 17 above, and further in view of Caruthers, Jr. et al. (U.S. Patent 6,002,893) (hereinafter “Caruthers, Jr.”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Caruthers, Jr. does not cure the deficiencies of Tosaka, Steele, and Fukutani regarding independent claims 1, 12, and 17 as discussed above. Each of claims 2, 5 through 7, 13, and 19, depend, directly or indirectly, from the independent claims. Therefore, the claims are non-obvious for at least the reason of depending from non-obvious independent claims.

**CONCLUSION**

Claims 1 through 7 and 9 through 21 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,



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